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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,147	03/07/2000	YI SUN	5780-01-TMC	8871

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EXAMINER

ROBINSON, HOPE A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 12/19/2001

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/508,147

Applicant(s)

SUN, YI

Examiner

Hope A. Robinson

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 2-4 is/are rejected.
- 7) ☐ Claim(s) 2-4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10. 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Applicant's election of Group II (claims 2-4) without traverse in Paper No. 9 is acknowledged.

#### ***Specification***

2. The disclosure is objected to because of the following informalities:

The specification is objected to because page 4 provides a "description of the drawings", however, no figures have been filed with the application. Applicant needs to delete the section of the specification entitled "description of the drawings" or submit the appropriate drawings.

Applicant should be mindful not to add new matter to the disclosure if drawings are submitted.

Correction is required.

#### ***Abstract***

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

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***Oath/Declaration***

4. The Oath/Declaration is objected to because the priority document, a provisional application is listed as 06/065,740 instead of 60/065,740.

***Claim Objection***

5. Claims 2-4 are objected to for the recitation of for example, "SEQ ID NO.8" as the notation should be "SEQ ID NO: 8". It is suggested that applicant delete the recitation of the sequence and only recite the sequence identifier as 37 CFR 1.821(d) indicates that reference must be made to the sequence by use of the sequence identifier, preceded by "SEQ ID NO:".

Compliance with the sequence rules is required.

***Claim Rejections - 35 U.S.C. § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6 Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and or use the invention. Claim 4 is directed to an isolated DNA fragment comprising the sequence set forth in SEQ ID NO: 23. The sequence comprises a repeat of one of the known motifs of the p53 binding sites. However, there is no indication in the description of the significance of this particular sequence, thus, the provision of a DNA fragment comprising two such motifs linked together does not provide adequate written description. The paper copy of the sequence listing provides the sequence, however, the specification does not contain a single reference to this sequence or any the required information about the sequence such as biological activity or a description of the any characteristics/attributes of the claimed sequence. Thus, given the claim breath and lack of guidance as discussed above, the specification fails to provide an adequate written description of the claimed invention. Accordingly, one of skill in the art would not be able to practice the claimed invention at the time of filing commensurate in scope with the claim.

***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 2 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Bian et al. (Carcinogenesis, vol. 17, no. 12, pages 2559-2562, 1996).

The claims are directed to isolated DNA fragments comprising the sequence contained in SEQ ID NOs: 8 or 10. Bian teaches the sequence set forth in SEQ ID NOs: 8 and 10 with a 100% sequence identity (see page 2560, right column, lines 32-33 of the reference). Thus, the limitation of the claims are met by this reference.

8. Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Draper et al. (U.S. Patent No. 5,248,670, September 28, 1993).

The claim is directed to an isolated DNA fragment comprising the sequence contained in SEQ ID NO: 10. Draper teaches the sequence set forth in SEQ ID NO: 10 with a 100% sequence identity (see the alignment). Thus, the limitation of the claim is met by this reference.

### ***Conclusion***

9. No claims are allowable.


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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hope A. Robinson whose telephone number is (703)308-6231. The Examiner can normally be reached on Monday and Wednesday - Friday from 9:00 A.M. to 5:30 P.M. (EST).


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor Christopher S.F. Low, can be reached at (703)308-2923.

Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703)308-0196.

Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-4242. Please affix the Examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

Hope A. Robinson, MS 

Patent Examiner



KAREN COCHRANE CARLSON, PH.D  
PRIMARY EXAMINER